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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,592	09/20/2000	Oyvind Breivik	28170-00020	1082

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EXAMINER

WONG, BLANCHE

ART UNIT	PAPER NUMBER
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2667

DATE MAILED: 04/05/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,592

Applicant(s)

BREIVIK ET AL.

Examiner

Blanche Wong

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. **Claim 7** are objected to because of the following informalities:

Examiner suggests dropping the definitive article – the – in the phrase “and the respective area code(s).”

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. **Claim 1** recites the limitation “the access network” in ln. 8 and “the relevant IN service” in ln. 18.

Claims 3 and 9 recite the limitation “the call set-up” in ln. 4 and ln. 3 respectively.

Claim 9 recites the limitation “the intelligent network (IN)” in ln. 3-4.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-3** are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Smyk (U.S. Pat No. 6,597,686).

With regard to claim 1, Smyk is a method for setting up telephone-to-telephone calls using telephones 202,226 (telephones) (see also 302 and unnumbered telephone in Fig. 3) connected to a PSTN/ISDN access network 204,224 (PSTN) and using a separate packet-switched network 214 (Internet) (see also 312,316 (switched telephone network)) as a by-pass network, wherein telephone gateways (GW) 206,216 (Internet telephony gateways) (see also 306,308,310,326,328,330 (POPs)) provide bridges Fig. 2 (see also Fig. 3) between the access network and said by-pass network, and connections being established between a calling party (A) telephone 202 (see also 302) and a first gateway (GWa) 206 (see also 306,308,310 (POPs)) and between a second gateway (GWb) 216 (see also 326,328,330 (POPs)) and a called party (B) telephone 226 (unnumbered telephone in Fig. 3).

Smyk also discloses a step of dialing, by a calling party (A) in a one-step procedure Fig. 9, a by-pass network service prefix 704 (calling party's preference

number; see col. 5, ln. 48-65) together with the number of the called party (B) 702 (called party's telephone number), said by-pass network service prefix comprising an IN-service prefix *13 (col.6, ln. 59-60).

Smyk also discloses a step of analyzing 806 (analyze signal and query SCP) said by-pass network service to identify the relevant IN service 810 (should the call be routed via STN or Internet) for thereby routing the call to an IN node which can execute this IN service 812,824 (SCP notifies POP's gateway about the incoming call and queries the gateway for assigned RN, SCP sends 'continue' to switch to route call via PSTN), the IN service establishing a call to said first gateway (GWa) 818 (established call between caller's phone and the gateway) selected from one of a plurality of gateways (GW), whereby said first gateway 818 is made service transparent 820 (POP's gateway connects the call to the called party) to the calling party (A) 822 (call established between the calling party and the called party). Fig. 7 and 8.

With regard to claim 2, Smyk also discloses said IN service 406 (intelligent peripheral) is adapted to find the closest gateway (GW) analyzing the calling party (A) number (col. 7, ln. 16, "prompts the caller"), each of said plurality of gateways being associated with geographic areas associated with calling party locations (col. 7, ln. 18-20, "assigns a route to the call just as if the call had been placed from the caller's registered telephone").

With regard to claim 3, Smyk also discloses the step after the IN service 406 (intelligent peripheral) has established the call to the first gateway (GWa) there is in the call set-up included the associated gateway number (GWa) as destination number, as

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well as the calling party (A) number and the called party (B) number. Fig. 9; see also col. 7, ln.17-20.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Smyk and White et al. (U.S. Pat No. 6,021,126).

With regard to claim 8, Smyk discloses a method as claimed in claim 1. However, Smyk fails to disclose the step of using the area code of the called party (B) number to find the IP-address of said second gateway (GWb), as recited in claim 8. In an analogous art, White discloses the step of using the area code of the called party (B) number (col. 8, ln.17-20) to find the IP-address (col. 11, ln.54-col. 12, ln. 20) of said second gateway (GWb), as recited in claim 8. At time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Smyk to include using area codes to find IP-addresses in order to facilitate a greater universality and applicability of the number portability system. Col. 7, ln. 20-22.

8. **Claim 9** rejected under 35 U.S.C. 103(a) as being unpatentable over Smky and White as applied to claim 8 above, and further in view of Voit (U.S. Pat No. 6,075,783).

With regard to claim 9, Smyk discloses a method as claimed in claim 1 and White discloses the step of using the area codes to find IP-addresses. However, Smky or White fails to disclose the step of including in the call setup from the intelligent network (IN) towards the first gateway (GWa) the IP-address of the second gateway (GWb), so that the first gateway (GWa) can use the received second gateway (GWb) IP-address in the remaining call handling process, as recited in claim 9. Voit discloses the step of including in the call setup from the intelligent network (IN) towards the first gateway (GWa) the IP-address of the second gateway (GWb) (col. 12, ln. 14, "returns the IP address to the caller"), so that the first gateway (GWa) can use the received second gateway (GWb) IP-address in the remaining call handling process, as recited in claim 9. At time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Smyk and White to include a step of returning the IP address to the calling party (A) in order to provide a high degree of mobility for roaming voice communications using the wide area network coverage provided by public packet data networks such as the Internet. Col. 5, ln. 10-14.

Allowable Subject Matter

9. **Claim 7** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Benash et al. (U.S. Pat No. 6,097,719) discloses a public IP transport network that uses a table relating a calling station's 9-digit postal zip code. Col. 18, ln. 39.

Response to Arguments

11. Applicant's arguments filed March 12, 2004, have been fully considered but they are not persuasive.

Smyk discloses the use of a by-pass network service prefix *13 together with the number of a called party to control the routing of a call through a packet-switched network, and dialing by a calling party together with the number of a called party (B). (Response to Office Action, p.9) Claim 1 does not recite the "preference information", or customer profile, cannot be the same as the "by-pass network service prefix" disclosed and claimed by Applicants, nor cite what is an IN-service prefix. (Response to Office Action, p.10)

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blanche Wong whose telephone number is 703-305-8963. The examiner can normally be reached on Monday through Friday, 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H Pham can be reached on 703-305-4378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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